

Mail Stop INTERFERENCES

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Not binding precedent

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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,297

SHIN-ETSU CHEMICAL CO. LTD.

(6,280,898 B1),

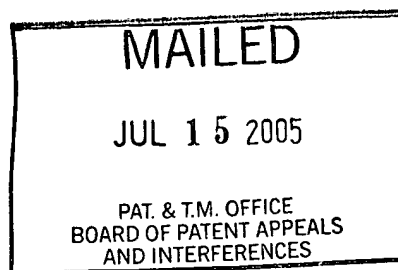
Junior Party,

v.

NEC CORPORATION

(09,750,116),

Senior Party,



Entered: 15 July 2005

Judgment - Bd. R. 127(b) - Requested

Before SCHAFER, TORCZON, and MOORE, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

Shin-Etsu has filed notice (Paper 32) of its abandonment of the contest with respect to count 2, the sole count. Abandonment of the contest is treated as a request for adverse judgment. Bd.R. 127(b)(4).

Shin-Etsu further expresses an intent to file a reissue application seeking claims directed to "subject matter removed from original Count 1", which Shin-Etsu states will not be subject to estoppel under Bd.R. 127(a)(1). We note that whether an estoppel exists depends on what precisely Shin-Etsu claims and that estoppel can arise both under the rule and also from the lost count itself. See In re Deckler, 977 F.2d 1449, 1452, 24 USPQ2d 1448, 1449 (Fed. Cir. 1992) (claims to patentably indistinct variant of lost count not patentable). We offer this caveat, not because we doubt Shin-Etsu's

good-faith intent and ability to file appropriate claims, but rather to avoid any misapprehension about the examiner's authority and duty to examine the reissue claims independently in view of the lost count and the prior art. See In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977) for an example of claiming around a lost count.

Shin-Etsu is correct that once the interference is terminated, the reissue application may be filed in the ordinary way and any patentability issues may be worked out through the ordinary reissue application examination process.

DECISION

In view of Shin-Etsu's concession, it is:

DECIDED that judgment on priority for the subject matter of count 2 is awarded against Shin-Etsu;

FURTHER DECIDED that Shin-Etsu claims 1-20, which correspond to count 2, are cancelled; and

FURTHER DECIDED that a copy of this decision be entered in the administrative records of Shin-Etsu patent 6,280,898 B1 and NEC application 09/750,116.

/Richard E. Schafer/
Administrative Patent Judge

/Richard Torczon/
Administrative Patent Judge

/James T. Moore/
Administrative Patent Judge

BOARD OF PATENT
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Notice: Agreements and understandings regarding the termination of an interference are subject to filing requirements under 35 U.S.C. 135(c).
Notice: In the event of judicial review, note the requirements of Bd. R. 8(b).